

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)	Confirmation No.: 8940
)	
Richard Schuster)	Art Unit: 3782
)	
Serial No.: 10/575,997)	Examiner: Gary E. Elkins
)	
Filed: April 17, 2006)	
)	
For: HANDLE AND TOP HANDLE)	
REINFORCEMENT FOR A)	
PAPERBOARD CARTON)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is filed pursuant to 37 CFR 41.41, in response to the Examiner's
Answer dated March 30, 2010.

Related Appeals and Interferences (Supplement):

It is noted initially that in related application 11/200,803, which claims were finally
rejected on similar art and which was the subject of an appeal, in lieu of providing an Examiner's
Answer in response to the Appeal Brief filed therein, Examiner Elkins reopened prosecution. In
the new Office Action, three new references were cited, namely: U.S. Patent Publication No.
2005/0061865 to *Marie, et al.* (now U.S. Patent 7,163,139), U.S. Patent No. 6,604,677 to
Sutherland et al., and U.S. Patent No. 2,308,050 to *Burr*. Although Applicant does not believe
these references are any more relevant to the present claims than the art upon which the Final

Rejections are based in this '997 application,¹ Applicant has filed an Information Disclosure Statement citing these three references and would appreciate an indication by the Examiner that these three references have been considered during examination of the present claims.

Argument:

The appealed claims stand finally rejected on the following grounds:

1. Claims 4, 5, 7, 8, 12-15, 36-39, 41, 42, and 46, unpatentable over *Brown* (U.S. Patent No. 5,350,109) in view of *Wilson* (U.S. Patent No. 5,072,876), either *Reeser* (U.S. Patent No. 2,568,204) or *Negelen* (U.S. Patent No. 6,250,542), and either *Sutherland* (U.S. Patent No. 6,112, 977) or *Skolik* (U.S. Patent No. 6,170,741), under 35 U.S.C. § 103(a);
2. Claims 36-39, 41, and 42; unpatentable over *Brown* in view of *Wilson*, either *Reeser* or *Negelen*, and *JP '243* (Japan 47-7243), under 35 U.S.C. § 103(a);
3. Claims 9, 16, and 43, unpatentable over the prior art as applied to claims 8, 15, and 42, respectively, and further in view of *Sherman* (U.S. Patent No. 3,166,229), under 35 U.S.C. § 103(a); and
4. Claims 10, 11, 17-20, and 44-45, unpatentable over the prior art as applied to claims 9, 16, and 43, and further in view of *Gilchrist* (U.S. Patent No. 3,533,549), under 35 U.S.C. § 103(a).

For the reasons discussed in the Appeal Brief filed January 6, 2010 ("the Appeal Brief"), Applicant contends that rejections (1) - (4) are not well taken, and requests that the final rejection be reversed. In addition, the Board is requested also to consider the following remarks, which are submitted in response to assertions and arguments presented in the Examiner's Answer.

Brown Cannot Be Modified As Proposed Without Destroying Its Intended Functionality:

The handle of the carton of *Brown* is intended to concertina to form a horizontal surface for ease of use by a user, i.e., to provide "an incipient handhold that is adapted to partially break

¹ The Examiner likely already considered that these references were no more relevant than the art applied to the claims in the instant application since the new Office Action in the '803 Application issued scarcely over a week after the Examiner's Answer in the instant application.

away from surrounding portions of a carton wall, and to sequentially collapse in a predetermined reverse folding or “concertina” fashion, to provide a folded load-bearing handhold structure.”²

To achieve such folding, *Brown* provides exterior and interior flaps that are “arranged in mutually co-operable register with the respective interior layer and exterior layer score lines positioned parallel and adjacent to one another in cooperative lower hinge-forming relation.”³

Both the Final Office Action and the Examiner’s Answer fail to provide (1) a reason to add an insert to *Brown*,⁴ (2) an insert with score lines or other means that would allow the insert to collapse with *Brown*’s handle as intended,⁵ or (3) a teaching of aligning insert score lines with score lines in the interior layer and exterior layer of the handle of *Brown* as would be required for the added insert to concertina. Instead, the Examiner’s Answer provided on page 8:

In response, providing a reinforcing layer around the handles in *Brown et al* does not require interference with or a change in the operation of the support flaps nor does it require another handle flap as part of the support flaps. The purpose of the support flaps in *Brown et al* is to form a horizontal surface for the hand, i.e. comfort during use and a distribution of the load along the hand. The purpose of the reinforcement is to reinforce the areas around the handle aperture and prevents tearing or bending of the paperboard area over the aperture during carrying of heavy items. Since the reinforcement as taught by the prior art is formed with an aperture and is used to reinforce around the aperture area, *it is unclear why such reinforcement would change the operation of the support flaps or would require a flap as part of the handle flap structure to operate. The remarks seem to be directed to a modification which is not being taught by the prior art, i.e. formation of inserts with aperture flaps. If the teaching of Wilson included such a handle flap, the argument regarding interference and/or destroying the principle of operation of the handle flaps in Brown et al would be more persuasive.* As for the argument that there is no reasonable expectation of success in providing a reinforcing layer around the handle apertures in *Brown et al*, the argument is not persuasive in that the other prior art illustrates success in providing such reinforcing layers. (*emphasis added*)

² See *Brown*’s Abstract.

³ *Brown*, column 2, lines 38-42.

⁴ In fact, providing an insert would appear to interfere with the function/operation of the buckling intended in *Brown*.

⁵ Score lines are not shown in any insert in the cited teaching references.

The Examiner's Answer entirely fails to address the underlying problem with using *Brown* as a base reference, namely that *Brown* cannot be modified as proposed since adding an insert between the interior and exterior layers of *Brown*, as allegedly taught by *Wilson*, would not allow the handle of *Brown* to function as intended. It appears instead that the Examiner's Answer presupposes that such an insert can be added to the carton of *Brown*, without providing any support in *Brown*, or any teaching in the prior art. The Examiner's Answer then misconstrues the Applicant's "change of operation" argument⁶ by asserting that a basis for such "change of operation" argument would exist only if the prior art taught "formation of inserts with aperture flaps." Specifically, the Examiner's Answer fails to address the fact that adding an insert without score lines between the interior and exterior layers would fail to allow the interior and exterior layers of *Brown* to fold along the score lines provided specifically to allow concertina of the handle. Thus, since adding an insert as proposed would change the principle of operation of *Brown* by not allowing the interior and exterior layers to collapse along the score lines, rejections based on modifications of *Brown* through addition of an insert fail to support a prima facie case of obviousness.

No motivation exists to modify *Brown* or to combine the art as proposed:

Further, the Examiner's Answer fails to address that a person of ordinary skill in the art viewing *Brown* would not be motivated to add an insert to increase strength since *Brown* specifically provides at column 2, lines 5-12 and column 7, lines 22-34 that the concertina folding action of *Brown*'s handhold is intended itself to provide the necessary strength for the

⁶ Applicant averred that *Brown* cannot be modified as asserted in the Final Rejection without changing the principle of operation of *Brown* (namely to concertina), which would be contrary to MPEP 2143.01(V).

carton. Further still, none of the cited teaching references suggest modification of the specific carton features of *Brown* or motivation to combine the disparate teachings of the distinct cartons of the cited art to reach the claims. The Examiner's only statements in this regard are at pages 2-3 of the Final Office Action:

It would have been obvious to provide reinforcement to the end wall handle apertures in Brown et al with an insert or inserts as taught by Wilson and to form the insert or inserts as a separate blank as taught by either Sutherland et al or Skolik et al as a matter of combining the elements according to known methods to yield the predictable results. See KSR Int'l Col. V. Teleflex Inc., 127 S.Ct. 1727, 1742; 82 USPQ2d 1385, 1396 (2007). It would further have been obvious to maintain the partial handle apertures in the end panel flaps 25 and 27 in modified Brown et al in view of the teaching in either Negelen or Reeser as a way of forming a three ply handle structure to reinforce the handle.

However, there is no "known method" for forming a three-ply handle in the *Brown* carton. Since *Brown* cannot be modified as proposed without destroying the functionality intended, the Examiner's reasoning that the elements would be combined "according to known methods to yield the predictable results" lacks support in *Brown* as such modification (a) is not predictable, as discussed above, and (b) does not yield predictable results. Even further still, the Examiner's Answer addressed three-ply structures on pages 9 and 10. However, the reasoning provided in the Examiner's Answer fails to address the fact that, without a teaching of the insert folding with the handle, *Brown* cannot be modified as proposed.

CONCLUSION

For the reasons stated in the Appeal Brief, supplemented by the foregoing, the subject matter of the appealed claims would not have been obvious to one of ordinary skill in the art over the combinations of references applied by the Examiner in the Final Rejection. It is therefore respectfully requested that the final rejection of claims 4, 5, 7-20, 36-39, and 41-46 be reversed.

Serial No. 10/575,997
Appeal Brief

The Commissioner is authorized to charge any fees that may be required for consideration of this

Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,

5/27/10
Date

Keats A. Quinalty
Keats A. Quinalty
Registration No. 46,426

Customer No. 26158
WOMBLE CARLYLE SANDRIDGE & RICE
P. O. Box 7037
Atlanta, Georgia 30357-0037
(404) 879-2423 (Telephone)
(404) 879-2923 (Facsimile)
Docket No.: R029 1410.3